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Supreme Court, U.S.
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No. 03-314

IN THE

Supreme Court of the United States

RICHARD SATAVA, an individual; SATAVA ART GLASS, a sole proprietorship,

Petitioners,

v.

CHRISTOPHER LOWRY, an individual; CHRISTOPHER RICHARDS, an individual; MAKAWAO GLASSWORKS, LLC, dba HOT ISLAND GLASS,

Respondents.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

REPLY BRIEF

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STATEMENT PURSUANT TO RULE 29.6

Petitioner, Satava Art Glass's corporate disclosure statement was set forth at page *ii* of its Petition for a Writ of Certiorari, and there are no amendments to that statement.

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INTRODUCTION

Respondents contend the Ninth Circuit's Opinion does not conflict with precedent because, they say, it does not establish a new threshold test for protectability to deprive art of copyright protection previously available under *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239 (1903) and its progeny. But Respondents ignore the first 11 pages of the 13-page Opinion, and the core holdings asserted therein, which the Ninth Circuit itself just read to require that it invalidate a copyright in a sculptural work on the ground the work was not sufficiently original to merit protection. *Lamps Plus, Inc. v. Seattle Lighting Fixture Co.*, __ F.3d __, 2003 WL 22285309 (CA9 Oct. 6, 2003). As the Ninth Circuit's own reading of its Opinion illustrates, and as the amici curiae brief filed in support of Petitioner Satava confirms, certiorari should be granted because the Opinion alters copyright law and narrows copyright protection for all art – not just depictions of animals – in a manner that conflicts with *Bleistein* and several circuits.

I. Certiorari Should Be Granted Because New Authority In The Ninth Circuit Confirms The Opinion In This Case Imposes A New Threshold Test That Deprives Artists Of Copyright Protection And Conflicts With Precedent

In his petition, Satava presented the questions of whether elements in a work of art said to be a "realistic" depiction of an animal or other subject matter in the public domain, or the combination of elements in such a work, were unprotectable under copyright law. Pet. *i* (Questions Presented 1 and 2). Respondents do not deny that such holdings would conflict with the precedent of this Court and other circuits, but rather attempt to portray the Opinion as not so holding by ignoring the first 11 pages of the Opinion.

Respondents' inability to reconcile the first 11 pages with precedent underscores the need for certiorari because those pages: (1) pose a threshold question "whether an artist's lifelike glass-in-glass sculptures of jellyfish *are protectable* by copyright," Pet. App. 2a; (2) hold those elements are

"*unprotectable*" because animals are in the public domain, *id.* at 9a; and (3) hold Satava's combination of elements, "lacks the quantum of originality needed to merit copyright protection." *Id.* at 10a. Indeed, that is exactly how the Ninth Circuit itself read the Opinion earlier this month:

> We have recently considered *the question whether a work* assembled from relatively few unprotectable elements *can be copyrighted as a sculptural work*, in *Satava v. Lowry*, 323 F.3d 805 (9th Cir. 2003). *Satava* concerned the *validity of a copyright* protecting the designer's glass-in-glass jellyfish sculptures. *Id.* at 808-10. In *Satava*, we ruled as follows:
>
> > Our case law suggests, and we hold today, that a combination of unprotectable elements is eligible for copyright protection only if those elements are numerous enough and their selection and arrangement original enough that their combination constitutes an original work of authorship.
> >
> > The combination of unprotectable elements in Satava's sculpture falls short of this standard. The selection of the clear galls, oblong shroud, bright colors, proportion, vertical orientation, and stereotyped jellyfish form, considered together, lacks the quantum of originality needed to merit copyright protection.
>
> *Id.* at 811 (internal citations omitted). Thus, we concluded in *Satava* that the combination of six *unprotectable* elements did not rise to the level of originality sufficient to merit copyright protection.
>
> . . . The Victorian Tiffany table lamp "lacks the quantum of originality needed to merit copyright protection." *Satava*, 323 F.3d at 811. [Plaintiff] Lamps Plus is *unable to survive the necessary first step*

> *of an infringement action because the copyright is invalid.* Consequently, we do not reach the question of whether the two lamps are substantially similar.

Lamps Plus, __ F.3d __, 2003 WL 22285309, at *6 (emphasis added). The Ninth Circuit is the fourth court in the past few months to apply its Opinion to deny or greatly restrict copyright protection for sculptural and or other works.[1]

The Ninth Circuit thus reads its Opinion in this case as (1) imposing a threshold test for determining whether works are protectable, (2) holding *all* six elements in Satava's art – including, necessarily, his depiction of a jellyfish – individually unprotectable, and (2) holding his combination of elements not sufficiently original to merit copyright protection. The Ninth Circuit then takes the Opinion to its logical conclusion, using it to invalidate the copyright for a sculptural work, *id.* at *3, on the ground the plaintiff could not survive the threshold test for originality established by the Opinion in this case. *Id.* at *6-7.

In this way, the Ninth Circuit not only confirms the overriding problem with the Opinion, it also reveals that the problem is greater than might appear on first blush. In *Lamps Plus*, the Ninth Circuit demonstrates that the Opinion's consequences extend far beyond works of art that depict animals and instead will be used to import from the law governing factual compilations a new threshold test for copyright protection of any sculptural or other work of art, regardless of whether it is based on scenes drawn from nature

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1. *See also Inkadinkado, Inc. v. Meyer*, 2003 WL 22282177, at *3 (D. Mass. Sept. 16, 2003) (denying preliminary injunction to artist on the ground that any protection in her compilation (a collage) was as "thin" as the protection, if any, given to factual compilations such as directories) (quoting Pet. App. 12a); *Cottrill v. Spears*, 2003 WL 21223846, at *9 (E.D. Pa. May 22, 2003) (quoting Opinion to find plaintiff's combination of elements insufficiently original to merit protection); *Osvaldo Garcia-Coyco v. Puerto Rico Highway Authority*, 275 F. Supp. 2d 142, 150 (D.P.R. 2003) (citing and quoting Opinion to justify invalidating copyright).

or other subject matter in the public domain. The Ninth Circuit's application of the Opinion in *Lamps Plus* thus emphasizes the need for certiorari in this case.

II. Certiorari Should Be Granted Because Respondents Do Not Even Attempt To Reconcile The Opinion With The Relevant Holdings Of *Bleistein* And Must Treat Art As "Facts" In A Vain Attempt To Reconcile It With *Feist*

In his petition, Satava explained why the Opinion could not be reconciled with *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239 (1903), and posed the questions of whether the Ninth Circuit's holdings also misapplied to *art* the rule regarding *factual* compilations set by *Feist Pubs., Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340 (1991). *See* Pet. *i* (Questions 2 and 3).

Just as Respondents can only deny the need for certiorari by ignoring the pertinent passages in the Opinion, they can only deny the conflict with *Bleistein* by ignoring its relevant holdings. *Bleistein* not only addressed the issue cited by the opposition (whether art used in advertisement is protectable), but also addressed whether plaintiff's lithographs were not sufficiently original to merit protection because they depicted actual scenes from a circus. 188 U.S. at 249. In rejecting this argument, Justice Holmes rejected *all* the foundational underpinnings of the Opinion.

First, Justice Holmes held copyright protection "is *not affected* by the fact, if it be one, that the pictures represent actual groups – visible things. . . . [E]ven if they had been drawn from the life, that fact would not deprive them of protection." *Id.* (emphasis added). Not only is this holding violated by the part of the Opinion Respondents ignore, it is also violated by that part Respondents quote, which holds a defendant *may* copy with impunity an artist's "'expression'" of what "'nature displays for all observers,'" and artists may only protect that part of their art, if any, that *varies* the depiction from the lifelike. Opp. 5 (quoting Pet. App. 12a). *Bleistein* holds the opposite. *Compare id.* and Pet. App. 7a-8a (Satava's sculptures unprotectable because, *inter alia*, jellyfish are "part of the public

domain" and thus "the common property of all") *with Bleistein*, 188 U.S. at 249 (such propositions "would mean that a portrait by Velasquez or Whistler was common property because others might try their hand on the same face. Others are free to copy the original. They are not free to copy the copy.").

Second, Justice Holmes explained that the combination of elements in even the simplest work of art was sufficiently original to merit copyright protection:

> There is no reason to doubt that these prints in their *ensemble* and in all their details, in their design and particular combinations of figures, lines, and colors, are the original work of the plaintiffs' designer. . . . It would be pressing the defendant's right to the verge, if not beyond, to leave the question of originality to the jury upon the evidence in this case. . . .

Id. at 250 (emphasis in original). It is apparent that this part of *Bleistein* cannot be squared with the Opinion's determination, ignored by Respondents, that an artist's combination of elements – which in this case was not only original but novel in that neither the Opinion nor Respondents deny that no artist had combined these elements in this fashion before Satava – lack sufficient originality to be protectable. Pet. App. 10a.

Finally, Justice Holmes rejected the theory that copyright protection for a work of art can be denied or limited based on comparison to factual compilations like a directory. *Id.* ("The least pretentious picture has more originality in it than directories and the like, which may be copyrighted."). In this way, *Bleistein* reveals the Opinion erred by extending the rule in *Feist*, which denies or limits copyright protection to directories and other factual compilations, to deny or limit copyright protection for art.

Respondents prove the point by conceding "[t]he *Feist* Court stated that the essential ingredient present in *creations*, but absent in *facts*, is originality. . . ." Opp. 12 (quoting *Feist*, 499 U.S. at 345) (emphasis added). To fit the Opinion's broad holding into the narrow rule of *Feist*, Respondents are

compelled to treat jellyfish sculptures as "facts," not as "creations," *id.*, but cannot cite even one other case using *Feist* to limit protection for artistic "creations." As confirmed by the amici curiae brief filed in support of Satava's petition, certiorari is necessary to prevent this erroneous extension of *Feist* to deny copyright protection to works of art.

III. Certiorari Should Be Granted To Address Conflicts Between The Opinion And Other Circuits That Respondents Do Not Attempt To Reconcile As To Four Circuits And Highlight As To Three Others

In his petition, Satava noted that the Opinion conflicts with decisions in at least seven other circuits. Amici curiae also observed that certiorari is required to resolve a conflict between the circuits as to when art, and the combination of elements that constitute a work of art, exhibits sufficient "creativity" to be protectable after *Feist*. *See* Amici Brief 4 (citing conflict between the Opinion and *Boisson v. Banian, Ltd.*, 273 F.3d 262 (CA2 2001)).

In opposition, Respondents can only argue that no conflict exists in the lower courts by ignoring several cases that conflict with the Opinion. Among others, Respondents never cite nor discuss the conflict between the Opinion and *Boisson*, *Tufenkian Import/Export Ventures, Inc. v. Einstein Moomjy, Inc.*, 338 F.3d 127 (CA2 2003); *Superior Form Builders, Inc. v. Dan Chase Taxidermy Supply Co.*, 74 F.3d 488 (CA4 1996); *Cannon Group, Inc. v. Better Bags, Inc.*, 250 F. Supp. 2d 893 (S.D. Ohio 2003) or any case outside the Ninth Circuit discussed in Pet. 18 n.15. These omissions are telling, for the cases Respondents fail to address highlight the conflict between the way these courts read *Bleistein* and/or *Feist* – and the greater copyright protection they accordingly give to artists and their creations than the Ninth Circuit – and the effect of the Ninth Circuit's failure to cite or follow *Bleistein* and its misapplication of *Feist*, which led it to significantly narrow copyright protection for artists and their creations. As a result, there are now two different

standards in the circuits for determining when and to what extent art will receive copyright protection.

Even the few decisions Respondents do address do not support their argument that no conflict exists between the Opinion and the other circuits. In each case, both the reasoning and result conflicts with the Ninth Circuit.

As even Respondents acknowledge, the First Circuit grants copyright protection to an artist's entire "'realistic-looking'" animal sculpture - not just to any variations added by the artist that alter his or her rendition from how the animal looks in nature. Opp. 8-9 (quoting *Concrete Machinery Co. v. Classic Lawn Ornaments*, 843 F.2d 600, 607-08 (CA1 1988). Contrary to the Ninth Circuit's approach, in the First Circuit the amount and nature of the artist's variations have nothing to do with plaintiff's entitlement to copyright protection, but are used during comparison of the parties' works to determine whether defendant's depiction of the animal copied plaintiff's rendition. 843 F.2d at 607-09. The Ninth Circuit never conducts this analysis; having erroneously concluded that Satava had no meaningful protection, the Opinion does not undertake an infringement analysis and never compares Satava's work with Respondents' to determine if they replicated his art (which, as the district court found, they had).

Respondents also concede that, in the Second Circuit, Satava's art would merit the very protection the Ninth Circuit denied. Opp. 9-10 ("'[o]riginality in this context means little more than a prohibition of actual copying'") (quoting *Rushton v. Vitale*, 218 F.2d 434, 435 (CA2 1955) (upholding copyright protection in chimpanzee soft sculptures based on live models because). Neither the Opinion nor Respondents claim that Satava copied any prior work, yet the Opinion denies copyright protection to Satava's sculptures because they supposedly depict actual jellyfish and "lack[] . . . originality. . . ." Pet. 10a.

As Respondents also concede, the Third Circuit accords copyright protection to "'relatively straightforward

representations of animal[s].'" Opp. 10 (quoting *Masquerade Novelty, Inc. v. Unique Industries, Inc.*, 912 F.2d 663, 671 (CA3 1990). Unlike the Ninth Circuit, the Third Circuit recognized that, under *Bleistein*, resolution of this type of case turns not on the protectability *vel non* of the art - since art is sufficiently original to merit protection - but on whether defendant copied plaintiff's realistic depiction of the animal. 912 F.2d at 671 (citing *Bleistein*).[2]

At the end of the day, Respondents' contention that the Opinion does not conflict with precedent turns on their untenable assertion that the Opinion does not hold Satava's sculptures to be unprotectable. Since the Ninth Circuit in *Lamps Plus* reads the Opinion to so hold, the conflict between the Opinion and the precedent cited by Respondents cannot be brushed aside on that basis.

That conflict is well-illustrated by the final case Respondents address, *Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 996 (CA2 1995). Contrary to Respondents' reading, *Knitwaves* did not adopt or follow what they contend is the holding of *Folio Impressions, Inc. v. Byer California*, 937 F.2d 759 (CA2 1991). Rather, the Second Circuit explicitly said that the appellant in that case - like Respondents here - accorded *Folio Impressions* "too broad a reading." *Knitwaves*, 71 F.3d at 1003. As the Second Circuit explained, the plaintiff in *Folio Impressions* "photocopied the background from a document . . . which was admitted to be in the public domain." *Id.* Because it was a direct *photocopy* - not an artist's rendition - "[t]he studio had 'contributed nothing, not even a trivial variation,'" the "background design was entirely devoid of originality" and "was not copyrightable." *Id.* (quoting *Folio Impressions*, 937 F.2d at 764). *Knitwaves*

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2. On remand, the district court in *Masquerade Novelty* found the similarities between the parties' renditions outweighed differences in the variations each had added, and thus found defendants' animal sculptures (in the form of masks) infringed plaintiff's work. 1990 U.S. Dist. LEXIS 16980 (E.D. Pa. 1990).

distinguished *Folio Impressions* from its facts – and from other cases involving art that was not photocopied from a document in the public domain – by noting that, under *Feist*, any work that "'was independently created by the author (as opposed to copied from other works), and that . . . possesses at least some minimal degree of creativity,'" is sufficiently original to merit copyright protection. *Id.* at 1004 n.3 (quoting *Feist*, 499 U.S. at 345).

Knitwaves also reveals the fundamental analytical flaw in the Ninth Circuit's Opinion. In *Knitwaves*, the Second Circuit never asks the threshold question posed by the Ninth Circuit because it was clear plaintiff's Squirrel and Leaf sweater design was not directly copied from another work and therefore was original and protectable. 71 F.3d at 1002; *see id.* at 1003-04 & nn.1 & 3. The question of originality and the scope of protection arose in the substantial similarity analysis, in which defendant argued that the Second Circuit should dissect out any unprotectable elements in plaintiff's design and not include those in its comparison with defendant's design. *Id.* at 1003. The Second Circuit *refused* to do so, explaining that "if we took this argument to its logical conclusion, we might have to decide that there can be no originality in a painting because all colors of paint have been used somewhere in the past." *Id.* (quotation omitted). In comparing "the works' 'total concept and feel,'" the Second Circuit compared plaintiff's combination of elements – the overall work, which the Ninth Circuit here found unprotectable – to defendant's and found the latter substantially similar and thus infringing. *Id.* at 1003-04.

As *Knitwaves* illustrates, the question of which elements in a plaintiff's art may be unprotectable leads to a much different answer and result when correctly considered as part of the substantial similarity analysis than if that question is converted into a stand-alone threshold test. Among other reasons, that is because any analytic dissection of unprotectable elements in the extrinsic prong of the substantial similarity analysis is balanced by comparing the "total concept and feel" of the parties' works in the intrinsic part of the test. *Id.* Taken out of that balanced context, the

analysis becomes one-sided and distorted, leading to a narrow view of what art is protectable that cannot be squared with a century of precedent finding virtually all art to be sufficiently original to be protectable, even if, in a given work, each element might independently be unprotectable. *Id.*; Pet. 18 n.15 (citing five cases so holding).[3]

CONCLUSION

As the concerns of amici curiae and the new authority from the Ninth Circuit illustrate, certiorari should be granted and the Opinion below reversed to protect both the uniform development and application of the Copyright Act and the ability of artists to obtain and enforce copyright registrations for their art. As shown by the Ninth Circuit's recent decision in *Lamps Plus*, unless certiorari is granted future courts will read and apply the Opinion to invalidate copyright registrations and eviscerate copyright protection for sculptural and other works of art. As shown by Respondents' own opposition, this reasoning and result does and will conflict with the precedent of this Court and decisions in at least seven other circuits. For all these reasons, the petition for certiorari should be granted and the Opinion below reversed.

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3. As explained in the Petition, the Ninth Circuit was only able to hold that Satava's constituent elements were unprotectable by ignoring the factual findings of the district court, which the Ninth Circuit never addressed nor found to be clearly erroneous. Instead, the Ninth Circuit relied on a number of its own personal misconceptions, which were at odds either with the factual record, *see, e.g.*, Pet. 9 n.2, or with the district court's factual findings, *see, e.g.*, Pet. 5 & n.1 and 23 & n.20. As part of their attempt to defend the indefensible, Respondents repeatedly make the same mistake; both their "Factual Background" and argument sections rely on factual assertions the district court *rejected* in its factual findings. *Compare, e.g.*, Opp. 2 (asserting "shroud" of outer glass was "a common shape that results from [the shape of the] object inside" and was thus easier and more economical to make) *with* Pet. App. 23a (rejecting this assertion based on evidence presented by Respondents as well as Satava); *and* Opp. 12-13 (asserting shape of Satava's shroud was "common" and thus in the "'public domain'") *with* Pet. App. 23a (finding shape of Satava's shroud was a "unique feature" of his art not in the public domain).

Respectfully submitted,

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